REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-18 are currently pending in the application. No claim amendments are presented, thus, no new matter is added.

In the Office Action, Claims 1-16 and 18 were rejected under 35 U.S.C. § 102(e) as anticipated by Bala et al. (U.S. Pub. 2003/0018644, herein Bala); and Claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over Bala in further view of Kobata et al. (U.S. Patent No. 7,051,003, herein "Kobata").

In response to the rejection of Claims 1-16 and 18 under 35 U.S.C. § 102(e), Applicants respectfully submit that independent Claims 1 and 18 recite novel features clearly not taught or rendered obvious by the applied reference.

Independent Claim 1 relates to an image forming apparatus including a display unit, and a display information controlling unit configured to control information displayed on the display unit. An interface unit is also included in the image forming apparatus and provides a physical connection with an external apparatus on which an application is implemented. A control unit controls the interface unit and provides a logical connection with the external apparatus. Independent Claim 1 further recites that the image forming apparatus, comprises:

> ... a relay unit configured to relay between the application and the software, said relaying unit ***notifying said display information control unit of a display that is to be presented on said display unit to indicate ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus***.

Independent Claim 18, while directed to a method, recites similar features. Accordingly, the remarks and arguments presented below are applicable to each of independent Claims 1 and 18.

Turning to the applied reference, Bala describes a method and program storage device for creating tabular data stream flow for sending rows of secure data between a client work-station and a server computer over a network using a common object request broker architecture (CORBA).[1] The method includes receiving a request to create a query form at the client work station, receiving a worksheet grid form defining selected tabular data, and packaging the worksheet grid form representing an updated status of the data for the tabular data stream flow.

Bala, however, fails to teach or suggest that the client device includes "a relay unit configured to relay between the application and the software, said relaying unit ***notifying said display information controlling unit of a display that is to be presented on said display unit to indicate ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus***," as recited in independent Claim 1.

In rebutting the arguments presented above, the Office Action asserts that since Bala describes a client, the reference anticipates all the features directed to the claimed "relay unit." More particularly, the Office Action appears to assert that functionally recited features directed to the "relay unit" and the "controlling unit" are not afforded patentable weight and that "the claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function."

Thus, it appears as though the Official Action has taken the position that the current claims cannot be distinguished based upon recited functionality. Yet, this position is entirely inconsistent with MPEP and relevant case law. For example, the Official Action relies upon the *In Re Schreiber* case as allegedly standing for the proposition that apparatus claims can

[1] Bala, Abstract.

only be distinguished based upon structural features; This is a clear misapplication of the *Schreiber* holding.

Schreiber does not stand for the proposition that apparatus functionality cannot be utilized as a distinguishing feature. In this regard, the Examiner is invited to review Section 2173.05(g) of the MPEP which makes it clear that a functional limitation is an attempt to define something by what it does, rather than by what it is. There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. Moreover, this portion of the MPEP goes on to state that **"a functional limitation must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used."** A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular **capability or purpose that is served by the recited element**, ingredient or step.

In other words, with specific reference to Claim 1, the functional language clarifies that the relay unit notifies the display information control unit of a display to be presented on the display to indicate ongoing preparation of the application until the application becomes operational when the control unit provides the logical connection with the external apparatus. There does not appear to be any discussion of the relay unit feature in this regard. Specifically, there is no discussion of the features of the notifying unit notifying the control unit of a display to be presented to indicate ongoing preparation of the application, as required in independent Claim 1.

Of course, it is well established that each word of every claim must be given weight. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well established that while the PTO is to give claim language its broadest "reasonable" interpretation, this does not mean that the PTO can completely ignore the understanding that

the artisan would have of the terminology "relaying unit notifying said display information control unit of a display that is to be presented on said display unit to indicate ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus". See In re Cortright, 165 F.3d 1353, 1358, 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999). ("Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach.") and In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976) citing In re Royka, 490 F.2d 981, 984, 180 USPQ 580, 582-83 (CCPA 1974).

Simply stated, the claimed ***relay unit*** provides a specific function as recited in the claims in terms of notifying the display to presented to indicate ongoing preparation of the application based on when the application becomes operational when the control unit provides the logical connection with the external apparatus. Rather than identifying the specific display to be presented and the circumstances of such a display relative to the cited art, the Official Action simply takes the position that this language can be ignored; This is wholly improper.

In rejecting the above emphasized features recited in independent Claim 1, the Office Action again relies on paragraphs [0041], [0069], and [0073]-[0074] of Bala. More specifically, the Office Action, at p. 4, asserts that the client 150 of Bala is analogous to the claimed image forming apparatus and the server 110 is analogous to the claimed external apparatus. As described at paragraph [0041], the client 150 runs a browser application, which allows the client to access a server 170 containing an initial launch web page for a strategic client planning system. The web server 170 also includes a logon applet that is sent to the client upon initial startup of the strategic client planning system and allows the client to establish an initial connection to a database 160 residing on a remote database server

computer 110. Thus, paragraph [0041] describes a process by which a client computer 150, which is already connected to a server 170, is able to access a database 160 residing on a remote database server 110. Accordingly, this cited portion of Bala fails to teach or suggest a relay unit that is configured to present a display on the display unit indicating ***ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus***. Instead, this portion of Bala merely describes a process of logging in to a remote database with which a connection is already established by way of a plurality of server computers, and fails to teach or suggest presenting a display indicating ongoing preparation of the application ***until the application becomes operational when said control unit provides a logical connection with the external apparatus***.

More particularly, in rejecting the claimed features directed to "said relaying unit notifying said display information controlling unit of a display ...", the Office Action relies on paragraphs [0073]-[0074] of Bala. This cited portion of Bala describes that data is downloaded from the database to the client 150 and a user at the client may locally make changes to the database material, but not upload the changes to the database until they are satisfied that the modified plans are ready for use by processes or users executing on the database 160. Once the user is satisfied with the modifications made to the data, the data may be imported to the database for permanent storage.

Thus, Bala describes that the client 150, in this instance, already has established a connection to the external database 160, or application, and is manipulating data downloaded from the database. The external application, or database, is already operational and a logical connection is already established with the server 110 storing the remote database 160. Thus, the cited portion of Bala clearly fails to teach or suggest a relay unit configured to notify the display of data that is to be presented on the graphical user interface of the client to indicate

ongoing preparation of the application until the application becomes operational when said control unit provides logical connection with the external apparatus, as recited in independent Claim 1. Instead, as noted above, in the cited portion of Bala, access to the application, or database 160, has already become operational to the user and the client workstation 150 has already established a logical connection with the remote server 110 containing the remote database 160.

Therefore, Bala fails to teach or suggest an image forming apparatus including a relay unit "configured to relay between the application and the software, said relaying unit notifying said display information controlling unit of a display that is to be presented on said display unit to indicate ***ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus***," as recited in independent Claim 1.

Accordingly, Applicants respectfully request that the rejection of Claim 1 (and Claims 2-16 which depend therefrom) under 35 U.S.C. § 102 be withdrawn. For substantially similar reasons, it is also submitted that independent Claim 18 patentably defines over Bala.

With regard to the rejection of Claim 17 under 35 U.S.C. § 103 as unpatentable over Bala in view of Kobata, it is noted that Claim 17 depends from Claim 1, and is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Kobata fails to cure any of the above-noted deficiencies of Bala.

Accordingly, Applicants respectfully request that the rejection of Claim 17 under 35 U.S.C. § 103 be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-8 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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